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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,957	12/18/2001	Wayne M. Doran	9852.00	7152

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EXAMINER	
WINTER, JOHN M	
ART UNIT	PAPER NUMBER
3621	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/20/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/022,957	DORAN, WAYNE M.	
	Examiner	Art Unit	
	John M. Winter	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 September 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *22-26,28 and 38-47* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *22-26,28 and 38-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status
Claims 22-26, 28 and 38-47 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22, 23, 25, 28, 38, 41, 43, 44 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claim 22 recites the limitation "if the determination in (b) is affirmed" this limitation is vague and indefinite, no limitiation is imposed upon the claimed invention.

Claims 23, 25, 28, 38, 41, 43, 44 and 46 contain similar limitations.

Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: " Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]" As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.

Response to Arguments

The Applicants arguments filed on September 28, 2006 have been fully considered.
The amended claims are rejected in view of Talati et al. (US Patent 5,903,878)
See following rejection .

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 22-26, 28 and 34-37, and 43-47 are rejected under 35 U.S.C. 102(e) as being unpatentable over Chang et al. (US Patent 5,884,288) in view of Bozeman (US Patent 6,754,640) and in further view of Talati et al. (US Patent 5,903,878).

As per claim 22,

Chang et al. ('288) discloses a computer implemented method by a financial institution, the method comprising, by a server associated with the financial institution:

receiving a request for a validation number to be associated with a check; (Figure 6 [bill payment database contains validation numbers])

Chang et al. ('288) does not explicitly disclose determining an account contains sufficient funds to cover the monetary amount of the check. Bozeman ('640) discloses determining an account contains sufficient funds to cover the monetary amount of the check. (Column 12, lines 7-19 [..checks for sufficient funds..]) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Chang et al. ('288). method with the Bozeman ('640) method in order to prevent illegal transactions from occurring.

Chang et al. ('288) does not explicitly disclose if the determination in is affmative, issuing a validation number to be associated with the check; Talati et al. ('878) discloses if the determination in is affmative, issuing a validation number to be associated with the check; (Column 7, lines 25-63) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Chang et al. ('288). method with the Talati et al. ('878) method in order to prevent illegal transactions from occurring by validating the transaction with the originating party..

Examiner note that is would be obvious to one of ordinary skill in the art at the time of the invention to utilize a random number in order to prevent transaction information from being associated with a customer's account, the Examiner notes that the usage of random numbers is common to many cryptography systems.

Claim 43 is in parallel with claim 22 and is rejected for at least the same reasons.

As per claim 23,

Chang et al. ('288) discloses a computer implemented method by a financial institution, the method comprising, by a server associated with the financial institution:

receiving a request for a validation number to be associated with a check; (Figure 6 [bill payment database contains validation numbers])

Chang et al. ('288) does not explicitly disclose determining an account contains sufficient funds to cover the monetary amount of the check. Bozeman ('640) discloses determining an account contains sufficient funds to cover the monetary amount of the check. (Column 12, lines 7-19 [..checks for sufficient funds..]) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Chang et al. ('288). method with the Bozeman ('640) method in order to prevent illegal transactions from occurring.

Chang et al. ('288) does not explicitly disclose if the determination in is affmative, issuing a validation number to be associated with the check; wherein the validation number is derived using at least some information associated with the check. Talati et al. ('878) discloses if the determination in is affmative, issuing a validation number to be associated with the check; wherein the validation number is derived using at least some information associated with the check. (Column 7, lines 25-63) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Chang et al. ('288). method with the Talati et al.

('878) method in order to prevent illegal transactions from occurring by validating the transaction with the originating party..

Claim 44 is in parallel with claim 23 and is rejected for at least the same reasons.

As per claim 24,
Chang et al. ('288) discloses a computer implemented method according to claim 23, wherein the at least some information associated with the check comprises:
Chang et al. ('288) does not explicitly disclose a date of the check; a serial number of the check; an account number of the account; a monetary amount of the check; a payee of the check; symbols identifying a drawee financial institution which maintains custody of the account; and a Uniform Resource Locator (URL). Talati et al. ('878) discloses a date of the check; a serial number of the check; an account numberof the account; a monetary amount of the check; a payee of the check; symbols identifying a drawee financial institution which maintains custody of the account; and a Uniform Resource Locator (URL). (Column 7, lines 25-44) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Chang et al. ('288). method with the Talati et al. ('878) method in order to prevent illegal transactions from occurring by validating the transaction with the originating party..

Claim 45 is in parallel with claim 24 and is rejected for at least the same reasons.

As per claim 25,
Chang et al. ('288) discloses a computer implemented method by a financial institution, the method comprising, by a server associated with the financial institution: receiving a request for a validation number to be associated with a check; (Figure 6 [bill paymeny database contains validation numbers])
Chang et al. ('288) does not explicitly disclose determining an account contains sufficient funds to cover the monetary amount of the check. Bozeman ('640) discloses determining an account contains sufficient funds to cover the monetary amount of the check. (Column 12, lines 7-19 [..checks for sufficient funds..]) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Chang et al. ('288). method with the Bozeman ('640) method in order to prevent illegal transactions from ocuring.
Chang et al: ('288) does not explicitly disclose if the determination in is affmative, issuing a validation number to be associated with the check; and allocating fimds for payment of the monetary amount if the determination in is affirmative. Talati et al. ('878) discloses if the determination in is affmative, issuing a validation number to be associated with the check; and allocating finds for payment of the monetary amount if the determination in is affinitive. (Column 7, lines 25-63) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Chang et al. ('288). method with the Talati et al. ('878) method in order to prevent illegal transactions from occurring by validating the transaction with the originating party..

Claim 46 is in parallel with claim 25 and is rejected for at least the same reasons.

As per claim 26,

Chang et al. ('288) discloses a computer implemented method according to claim 25, wherein (d) comprises:

Chang et al. ('288) does not explicitly disclose deducting the monetary amount from the account. Talati et al. ('878) discloses deducting the monetary amount from the account. (Column 7, line 64 – column 8 line 16) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Chang et al. ('288). method with the Talati et al. ('878) method in order to profit from the transaction.

Claim 47 is in parallel with claim 26 and is rejected for at least the same reasons.

Claims 28 is rejected under 35 U.S.C. 102(e) as being unpatentable over Chang et al. (US Patent 5,884,288) in view of Bozeman (US Patent 6,754,640) and further in view of Joao et al. (US Patent 5,878,337) and in further view of Talati et al. (US Patent 5,903,878)

As per claim 28,

Chang et al. ('288) discloses a computer implemented method by a financial institution the method comprising by a server associated with the financial institution:

Receiving a validation number associated with a check;(Figure 6 [bill payment database contains validation numbers])

issuing a validation number the check associated with the check.(Column 8, lines 4-12[check is transmitted to payee])

Chang et al. ('288) does not explicitly disclose determining an account contains sufficient funds to cover the monetary amount of the check. Bozeman ('640) discloses determining contains sufficient funds to cover the monetary amount of the check. (Column 12, lines 7-19 [..checks for sufficient funds..]) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Chang et al. ('288). method with the Bozeman ('640) method in order to prevent illegal transactions from occurring.

Chang et al. ('288) does not explicitly disclose wherein the request identifies the account. Joao et al. ('337) discloses wherein the request identifies the account. (Column 5, 26-50) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Chang et al. ('288). method with the Joao et al. ('337) method in order to prevent illegal transactions from occurring.

Chang et al. ('288) does not explicitly disclose if the determination made is affirmative issuing a validation number to be associated with the check; verifying that the request was made by a party authorized to write checks on the account; and verifying that the account contains sufficient funds to cover the monetary amount of the check. Talati et al. ('878) discloses if the determination made is affirmative issuing a validation number to be associated with the check; verifying that the request was made by a party authorized to write checks on the account; and verifying that the account contains sufficient funds to cover the monetary amount of the check. (Column 7, lines 25-63) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Chang et al. ('288). method with the Talati et al. ('878) method in order to prevent illegal transactions from occurring by validating the transaction with the originating party.

Claims 38-42 are rejected under 35 U.S.C. 102(e) as being unpatentable over Chang et al. (US Patent 5,884,288) in view of Talati et al. (US Patent 5,903,878).

As per claim 38,
Chang et al. ('288) discloses a system comprising:
means for receiving, from a first requestor, a request over the Internet for a validation number to be associated with a check;(Figure 6 [bill payment database contains validation numbers])

Chang et al. ('288) does not explicitly disclose means for establishing a reference character sequence for the check; means for transmitting the reference character sequence to the first requestor over the internet; Talati et al. ('878) discloses means for establishing a reference character sequence for the check; means for transmitting the reference character sequence to the first requestor over the internet; (Column 7, lines 25-63) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Chang et al. ('288). method with the Talati et al. ('878) method in order to prevent illegal transactions from occurring by validating the transaction with the originating party..
as per the feature of " means for receiving, from a second requestor, a proposed character sequence over the Internet" The mere duplication of a process does not merit patentability.

Claim 41 is in parallel with claim 38 and is rejected for at least the same reasons.

As per claim 39,
Chang et al. ('288) discloses a system according to claim 38,
Official Notice is taken that " the validation number is randomly generated by a financial institution" is common and well known in prior art in reference to security protocols. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a random number in order to prevent transaction information from being associated with a customer's account, the Examiner notes that the usage of random numbers is common to many cryptography systems.

As per claim 40,
Chang et al. ('288) discloses a system according to claim 38,
Chang et al. ('288) does not explicitly disclose wherein the validation number is derived using at least some information associated with the check.; Talati et al. ('878) discloses wherein the validation number is derived using at least some information associated with the check. (Column 7, lines 25-63) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Chang et al. ('288). method with the Talati et al. ('878) method in order to prevent illegal transactions from occurring by validating the transaction with the originating party..

As per claim 42,
Chang et al. ('288) discloses a system according to claim 41,

A method according to claim 41, wherein the first party is a payor of the cheek, and the second party is a payee of the check. (Figure 5)

Conclusion

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Winter whose telephone number is (571) 272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John Winter
Patent Examiner -- 3621

PRIMARY EXAMINER